

REMARKS / DISCUSSION OF ISSUES

Claims 1-4 and 6-21 are pending in the application. Claims 17-20 are amended to place the claims in better condition for allowance or appeal by correcting a mis-directed reference to a control element in these claims. Additional search is not required because no new matter is added, and the scope of the claims is unchanged.

The Office action rejects claims 1-4 and 6-21 under 35 U.S.C. 112, first paragraph. The applicants respectfully traverse this rejection.

The Office action asserts that the specification does not disclose that for each present user, two playback modes are provided, a first mode in which the selection of content is based on the dislikes of the user, and a second mode in which the selection of content is based on the likes of the user. The applicants respectfully disagree with this assertion. At page 5, lines 22-28, the applicants specifically teach:

"Whenever a person X enters the room where the audio player 1 is located, the person may choose to press his/her personal presence button, either half or completely. If a presence button of person X is half-pressed, then this will have the effect that songs that person X particularly dislikes will not be played. If a presence button of person X is fully-pressed, then the player will try in addition to play songs that are liked by X, taking into account the preferences of other persons that also have indicated their presence."

As is clearly evident, the specification clearly teaches that if the user's button is half-pressed, the playback for that user is in a first mode, and if it is fully-pressed, the playback for that user is in a second mode.

Because the applicants' specification clearly and reasonably conveys to one of skill in the art that the inventors had possession of the claimed invention at the time the application was filed, the applicants respectfully maintain that the rejection of claims 1-4 and 6-21 under 35 U.S.C. 112, first paragraph, is unfounded, and should be withdrawn.

The Office action rejects claims 11 and 19-21 under 35 U.S.C. 101. The applicants respectfully traverse this rejection. However, in the interest of advancing prosecution in this case, claim 11, upon which claims 19-21 depend, is amended to recite that the method is embodied on a playback device. Reconsideration of this rejection is respectfully requested.

The Office action rejects claim 12 under 35 U.S.C. 101. The applicants respectfully traverse this rejection. In the interest of advancing prosecution, claim 12 is amended to specifically recite that the computer program is stored on the computer-readable medium. The applicants respectfully maintain that the claimed computer-readable medium must be 'physical' in order to 'store' a computer program.

Additionally, the Office action asserts that because computer-readable media includes signals, the claim is directed to non-statutory subject matter. The applicants respectfully disagree with this assertion. The applicants note that MPEP 2106.1 states the fact that computer-readable media includes signals, yet does not summarily conclude that this fact (which is true regardless of whether it is stated in an application) renders all claims to a computer-readable medium non-statutory.

The Office action rejects claims 1-2 and 6-21 under 35 U.S.C. 103(a) over Kosmi (USP 7,293,060), Zamir et al. (USPA 2003/0236582, hereinafter Zamir), and Cliff (USP 6,746,246). The applicants respectfully traverse this rejection.

In *KSR Int'l. Co. v. Teleflex, Inc.*, the Supreme Court noted that the analysis supporting a rejection under 35 U.S.C. 103(a) should be made explicit, and that it is "important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements" in the manner claimed:

"Often, it will be necessary ... to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an **apparent reason** to combine the known elements **in the fashion claimed** by the patent at issue. To facilitate review, this analysis should be made explicit." KSR, 82 USPQ2d 1385 at 1396 (emphasis added).

The applicants respectfully maintain that, absent the applicants' disclosure, one of skill in the art would have no apparent reason to combine Kosmi, Zamir, and Cliff in the manner claimed by the applicants.

Kosmi teaches an electronic disc jockey service; Zamir teaches selection of items based on user reactions, and Cliff teaches a method and system for composing a song. The applicants respectfully maintain that there is no apparent reason to combine techniques for composing a song (Cliff) with a system for selecting songs for playback (Kosmi and Zamir).

The Office action asserts that one would be motivated to include a means for registering the dislike of a crowd to a delivered media as taught by Cliff within a combination of Kosmi and Zamir "for the purpose of detecting crowd reaction to a delivered media and tailoring content toward positive expression of crowd reaction" (Office action, page 6, lines 13-18). The applicants note, however, that this asserted motivation is unrelated to the applicants' claimed invention, and does not provide an apparent reason to combine Cliff with Kosmi and Zamir "in the fashion claimed" by the applicants, as required by KSR.

The applicants also note that, assuming in argument that one were to combine Cliff with Kosmi and Zamir, the combination of Kosmi, Zamir, and Cliff does not disclose each of the elements of the applicants' independent claims 1, 11, and 12. MPEP 2143 clearly notes that to support an obviousness-type rejection based on the combination of prior art elements according to known methods to yield predictable results, the Examiner must first articulate:

"a finding that the prior art included each element claimed, although not necessarily in a single prior art reference, with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference"

The combination of Kosmi, Zamir, and Cliff fails to disclose selecting content material for playback such that, for each user, if the playback mode of the user is a first mode, the selection of the content material is based on the dislikes of the user, and if the playback mode of the user is a second mode, the selection of the content material is based on the likes of the user, as claimed in each of the applicants' independent claims.

The Office action fails to identify where any of Kosmi, Zamir, or Cliff teaches using two different and distinct techniques/criteria for selecting content material, and fails to identify where any of Kosmi, Zamir, or Cliff teaches that the choice of which of these different techniques/criteria are to be applied is provided for each user of a plurality of users. The Office action asserts that Kosmi teaches that each user may choose to affect an overall playback mode at column 4, lines 55-67. The applicants respectfully disagree with this assertion. At the cited text, Kosmi teaches:

"The client station(s) 302A, 302B may include various hardware and/or software for receiving and processing content from the content-control station 305 and/or for providing the content to the output devices 303. The software may further receive and process upstream feedback from one or more of the users 310 directed toward the client station 302 and/or the electronic disc jockey service 102. Such feedback may be in form of providing data such as photographs, live video, stored video clips, voice or text messages, and the like, which may be intended for sharing with other users 310 in the party community 101. User feedback may further be in the form of requests directed to the electronic disc jockey service 102 to provide the party community 101 (or a subset thereof) with particular content." (Kosmi, column 4, line 55 - column 5, line 2.)

As is clearly evident, the cited text does not address different playback modes, and specifically does not disclose that each user may choose to affect a playback mode, as asserted in the Office action.

The applicants also note that choosing to affect a mode, does not correspond to choosing between two modes, as taught and claimed by the applicants. The applicants also note that a selection based on both the likes and dislikes of a user does not correspond to a selection based on either the likes or dislikes of each user, as taught and claimed by the applicants.

Because there is no apparent reason to combine Kosmi, Zamir, and Cliff in the fashion claimed, and because even if such a combination were formed, the combination of Kosmi, Zamir, and Cliff does not disclose the elements of each of the applicants' independent claims, the applicants respectfully maintain that the rejection of claims 1-2 and 6-21 under 35 U.S.C. 103(a) over Kosmi, Zamir, and Cliff is unfounded, and should be withdrawn.

The Office action rejects claims 3-4 under 35 U.S.C. 103(a) over Kosmi, Zamir, Cliff, and Vong et al. (USP 6,917,313, hereinafter Vong). The applicants respectfully traverse this rejection.

Each of claims 3 and 4 is dependent upon claim 1, and in this rejection, the Office action relies on the combination of Kosmi, Zamir, and Cliff for teaching the elements of claim 1. As noted above, there is no apparent reason to combine Kosmi, Zamir, and Cliff in the fashion claimed in claim 1, and even if such a combination were to be formed, the combination of Kosmi, Zamir, and Cliff fails to disclose each of the elements of claim 1. Accordingly, the applicants respectfully maintain that the rejection of claims 3-4 under 35 U.S.C. 103(a) that relies on the combination of Kosmi, Zamir, and Cliff for teaching the elements of claim 1 is unfounded, and should be withdrawn.

In view of the foregoing, the applicants respectfully request that the Examiner withdraw the objection(s) and/or rejection(s) of record, allow all the pending claims, and find the application to be in condition for allowance. If any points remain in issue that may best be resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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